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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,885	04/02/2001	Marie Bern	15292.3	5867

22913 7590 10/21/2005

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EXAMINER

LAZARO, DAVID R

ART UNIT	PAPER NUMBER
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2155

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/720,885

Applicant(s)

BERN, MARIE

Examiner

David Lazaro

Art Unit

2155

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1,4-9 and 11-13.
Claim(s) withdrawn from consideration: _____.


AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


SALEH NAJJAR
SUPERVISORY PATENT EXAMINER


David Lazaro
October 18, 2005

Continuation of 3. NOTE: In Claim 9, the limitation "in response to receiving said identifier from said mobile station" would require further search and consideration. The previous language of the claim did not require the accessing of information to be necessarily in response to receiving the identifier to the mobile station. As such, the proposed amendment to claim 9 would require further search and consideration.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues on page 10 of the remarks: "It is inherent from the teachings of Tso that the reason why all data files that are not already stored on the infocast server must be obtained by the client directly accessing the content provider using a back channel that bypasses the infocast server is to maximize the conservation of bandwidth"

Examiner's response: The examiner respectfully disagrees as there is nothing said by Tso that would prove that such a reason is inherent in the invention of Tso. While it is implied that such aspects of bandwidth conservation would be beneficial and in some cases preferable, this is not inherency as it is not a necessity of the invention.

Applicant argues on page 10 of the remarks: "That is, the Tso patent specifically discloses a system wherein small, frequently used data files can be quickly accessed because they are stored on the infocast server and because they only require minimal bandwidth. In turn, larger data files that would require significant bandwidth for the infocast server to transmit to the client are required under the Tso patent to be accessed directly by the client by bypassing the infocast server."

Examiner's response: Nowhere in Tso is it stated that larger files needing significant bandwidth are REQUIRED to be accessed directly by the client. Applicant extracts this meaning in part from Col. 5 line 49. However, this section of Tso also states, "Server content database 51 contains data used by the Infocast server in serving the users currently in its territory. Server content database 51 contains data received from sources such as content provider A5, content provider B7..." (Col. 5 lines 33-36). After this, Tso then states "Moreover, server content database 51 is PREFERABLY used to contain resources that are often used to reduce accessing time but yet of relatively small size to conserve space"(emphasis added Col. 5 lines 47-50). As such, there is no "requirement" as argued by applicant, only a preferred embodiment. Furthermore, it is noted that MPEP 2123 states "A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989)." and "Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments."

Applicant argues on page 11: "Applicant respectfully submits that there is not motivation to make such a modification since such a modification would destroy the intended function, purpose, and operation of the Tso patent. Specifically, such a modification would enable one or more select clients to occupy substantial amounts of bandwidth and thereby decrease access time for all clients and/or potentially create other bandwidth problems. Furthermore, such a modification would destroy the intended operation of the Tso patent in that it would eliminate the back channel interface and storing information on the infocast server."

Examiner's response: The examiner disagrees with applicant's assessment of the intended function, purpose, and operation of the Tso patent. According to the background and summary of the invention, the intended function, purpose, and operation of Tso is for improving upon the distribution of information to different users. The summary states "Instead of relying on the efforts of a user to find and retrieve information, the present invention allows Infocast server to send information or a pointer to the information such as a uniform resource location (URL) directly to the user." Col. 2 lines 40-42, states "The invention provides a method and apparatus for automatically distributing electronic information to a targeted group of users". Modifying Tso as indicated by Hawkins would not destroy the intended function, purpose, and operation of the Tso patent since users as the infocast server can still send information or a pointer to the information and electronic information can still be automatically distributed to a targeted group of users. Therefore, applicant's arguments are not persuasive.